

REMARKS

Claims 1-20 are currently pending in the Application. In the above amendment, Applicant's representative has cancelled claim 1, and has amended claim 2.

In the Notice of Non-Compliant dated March 16, 2005, the Examiner objected to the status identifier of claim 1. The amendment has been corrected to clearly show the status identifier as "Canceled."

In the Office Action dated September 10, 2004 ("Office Action"), the Examiner objected to the Specification, rejected claims 1-20 under 35 U.S.C. § 101, rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by Peri, U.S. Patent No. 6,079,032 ("Peri"), and indicated that claims 2-6 would be allowable if rewritten in independent form, and that claims 7-20 are allowable. Applicant's representative respectfully traverses the 35 U.S.C. § 101 rejections of claims 1-20.

With regard to the 35 U.S.C. § 101 rejections, Applicant's representative wishes to first point out that method claims are generally directed to processes, and processes are the first statutory subject matter listed 35 U.S.C. § 101. The USPTO has published a guideline for software examination entitled "Examination Guidelines for Computer-Related Inventions." In section 2(b) of this guideline, entitled "Statutory Process Claims," examples and descriptions of statutory process claims are provided. In addition, the guidelines state in section 2(b)(i):

If a claim does not clearly fall into one or both of the safe harbors, the claim may still be statutory if it is limited by the language in the claim to a practical application in the technological arts.

As amended above, claim 2 now reads:

2. A method for instrumenting a software program, the method comprising:

embedding within the software program a user-defined measurement type instance based one of a plurality of predefined measurement types, wherein the user-defined measurement type instance includes a measurement type designation and associated variables; and

storing data structures representing the embedded user-defined measurement type instance.

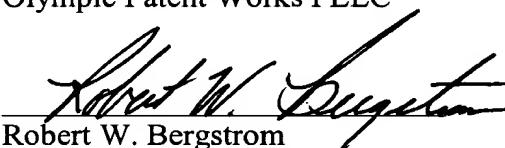
Claim 2 clearly claims a practical application, and includes steps that embed user-defined measurement types into a program and that store data structures representing the user-defined measurement types. Instrumentation of software programs is commonly carried out to analyze the run-time behavior of programs, in order to optimize and debug programs. Comparison of claim 2 to the above-referenced guideline reveals that claim 2 is a statutory process claim.

Finally, regarding the 35 U.S.C. § 101 rejections, Applicant's representative respectfully submits that the Examiner's proposed amendments, resulting in claims that begin "A method executing on a computer readable medium ..." would result in claims that are not directed to the invention to which the claims, as originally submitted, are directed. A method does not generally execute on a computer readable medium. Computer readable media include electronic memories, mass-storage devices, CDs, DVDs, floppy disks, and other such information-storage media. Computer programs that embody methods, by contrast, execute within one or more processors. While it is true that claims directed to data structures stored on computer readable media have been found to be statutory claims by the Federal Circuit, the methods to which the originally submitted claims are directed include steps that differ from simply storing data structures on a computer readable medium.

Should the Examiner continue to question whether claims 2-20 are directed to statutory subject matter under 35 U.S.C. § 101, Applicant's representative would be happy to discuss the matter in a telephone interview, to supply additional materials in support of Applicant's position, or to consider additional suggestions by the Examiner for amendments.

In the interest of facilitating a successful and expedient allowance of the current claims, Applicant's representative has cancelled rejected claim 1 and has rewritten claims 2, as an independent claim, to include all of the limitations previously included in claim 1. Finally, Applicant's representative would like to thank the Examiner for the conditional allowance of claims 2-20. All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,  
David Arthur Stephenson  
Olympic Patent Works PLLC

  
Robert W. Bergstrom  
Registration No. 39,906

Enclosures:  
Postcards (2)  
Transmittal in duplicate

Olympic Patent Works PLLC  
P.O. Box 4277  
Seattle, WA 98194-0277  
206.621.1933 telephone  
206.621.5302 fax